

Appl. No. 10/530,096  
Amdt. Dated February 15, 2007  
Reply to Office Action of November 15, 2006

**... ARGUMENTS/REMARKS ...**

The Office Action of November 15, 2006 has been thoroughly studied. Accordingly the changes presented herein for the application, considered together with the following remarks, are believed to place the application into condition for allowance.

By the present amendment, claim 15 has been amended to delete "harnesses." at the end of the claim. This change merely corrects an obvious typographical error.

Entry of the changes to the claims is respectfully requested.

On page 2 of the Office Action the Examiner has objected to claim 15, indicating the "harnesses" should be deleted at the end of the claim.

Claim 15 has been corrected in the manner suggested by the Examiner.

Claims 2-5, 7-9, 15-18 and 32 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Under this rejection the Examiner takes the position that:

In Claims 2-5, it is not clear as to what Applicants intend to claim, i.e., a sealing material or an automobile engine cam cover.

In Claims 7-9, it is not clear as to what Applicants intend to claim, i.e., a sealing material or an automobile engine oil pan.

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In Claims 15-18 and 32, it is not clear as to what Applicants intend to claim, i.e., a sealing material or an automobile wiring harness.

From the rejection of claims 2-5, 7-9, 15-18 and 32 stand rejected under 35 U.S.C. §112, second paragraph it appears that the Examiner has not given weight to the fact that these claims are directed to combinations of the sealing material with: 1) an automobile engine cam cover (claims 2-5); 2) an automobile engine oil pan (claims 7-9); and 3) an automobile wire harness (claims 15-18 and 32).

The use of "combination claims" is well known and accepted practice before the U.S. Patent and Trademark Office.

The undersigned conducted a search on the phrase "in combination" in the "claims" field of pending patents on the U.S. Patent and Trademark Office website and uncovered over 3,000 patent applications that contain this term. Further searching confirmed that a number of the 3,000 applications issued with claims that recited in their preambles: "In combination..."

(Note: a similar search on issued U.S. Patents was not possible because terms "in" and "with" (such as "in combination with") were dropped from the searching algorithm. Nevertheless, it is expected that there are far many more issued patents that contain "combination" claims.)

One typical example of a "combination" claim in an issued patent is claim 7 of U.S. Patent No. 6,925,719 recites:

*In combination:* a full dental arch model including: a positive die of a full dental arch including: gums; and a plurality of teeth; and an arch plate connected to said die; said full arch model being U-shaped in top view with opposing left and right sections; a

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coping saw for cutting individual dies from said dental model including: a blade assembly having a proximal end; said blade assembly including: an elongate, blade having a longitudinal axis and having a thickness adapted for cutting individual dies from said model including a proximal end; and a distal end; and a rigid frame including: a proximal end connected to said proximal end of said blade; and a distal end connected to said distal end of said blade; said frame for supporting said blade in tension; a housing including: handle means for holding said saw in a hand, a rotary motor mounted to said housing including: a drive shaft rotating about a shaft axis including: a front end; power means for powering said motor; a piston slideably and non-rotatably supported in said housing including: a front end connected to said blade assembly for moving said blade assembly along the longitudinal axis of said blade coincident with piston movement; and a rear end; and motion converter means for connecting said front end of said drive shaft to said rear end of said piston for converting rotary motion of said drive shaft into reciprocating linear motion of said piston resulting in a stroke length of said blade assembly of less than the distance between opposing U-sections along a cut line; said motion converter means including: an exterior surface on said drive shaft front end including: a circumferential raceway in a plane at an angle to the shaft axis; a cap on said rear end of said piston having an inside surface; said cap fitting over said exterior surface of said front end of said drive shaft; and coupling means moving in said raceway for coupling with said cap to move said cap.

Applicants' claim 2 recites:

A sealing material *in combination* with an automobile engine cam cover wherein the sealing material seals the automobile engine cam cover and comprises a cured product of a composition comprising (A) an acrylic polymer having at least one alkenyl group capable of undergoing hydrosilylation reaction, (B) a hydrosilyl group-containing compound and (C) a hydrosilylation catalyst as essential components.

It is submitted that the format of applicants' "combination" claims is not materially or substantially different from the example of the "combination" claim set forth above (claim 7 of U.S. Patent No. 6,925,719).

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In each instance, such "combination" claims recite elements in the particular combination which must be considered and found in the prior art, in the recited combination, for proper examination of the claims.

Based upon the above, it is submitted that applicants' "combination" claims are definite under 35 U.S.C. §112, and require examination as to all of the recited elements of the combination.

Should the Examiner request, applicants will amend the dependent claims to refer to the "combination" of their respective independent claims.

Claims 2-10, 15-19, and 32 remain pending in this application.

Claims 2-5, 7-9, and 15-18 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-10 of copending application serial No. 10/506,488.

Claims 2-9 and 15-17 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese reference No. 2000-154255 to Fujita et al.

Claims 18 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fujita et al.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,394,853 to Lopez-Crevillen et al. in view of Fujita et al.

On page 5 of the Office Action the Examiner has noted that claim 19 is presently allowed.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding prior art rejections should properly be withdrawn.

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Favorable reconsideration by the Examiner is earnestly solicited.

The pending claims 1-10 of copending application serial No. 10/506,488 are reproduced herein as follows:

Claim 1. A material for vibration-absorbable mounts that has a loss tangent ( $\tan \delta$ ) of at least 0.5, which comprises a cured product of a composition comprising (A) an acrylic polymer having at least one alkenyl group capable of undergoing hydrosilylation reaction, (B) a hydrosilyl group-containing compound and (C) a hydrosilylation catalyst as essential components.

Claim 2. A material for vibration-absorbable mounts according to Claim 1, wherein a liquid acrylic polymer having a number average molecular weight  $M_n$  of 500 or more and a molecular weight distribution ( $M_w/M_n$ ) of 1.8 or less is used as component (A) of the composition.

Claim 3. A material for vibration-absorbable mounts according to Claim 1, wherein the cured product of the composition has a Duro A hardness of 45 or less.

Claim 4. A material for vibration-absorbable mounts according to Claim 1, wherein 100 parts by weight or less of a reinforcing agent or filler is added to the composition on the basis of 100 parts by weight of the sum total of components (A), (B) and (C).

Claim 6. A material for vibration-absorbable mounts according to Claim 1, which comprises an article that is in a contact with electronic components or electronic assemblies.

Claim 7. A material for vibration-absorbable mounts according to Claim 1 comprising a vibration-absorbable mount for a hard disc drive.

Claim 8. A material for vibration-absorbable mounts according to Claim 7, wherein the material for vibration-absorbable mounts is fixed to a cover of a box housing the hard disc drive.

Claim 9. A material for vibration-absorbable mounts according to Claim 7, comprising a vibration-absorbable mount for a hard disc drive that is mounted

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in an automobile.

Claim 10. A material for vibration-absorbable mounts according to Claim 3, wherein 100 parts by weight or less of a reinforcing agent or filler is added to the composition on the basis of 100 parts by weight of the sum total of components (A), (B) and (C).

The Examiner will note that these claims are directed to a material for vibration-absorbable mounts.

In contrast, the claims of the present application are directed to various sealing applications which require and rely upon properties of the materials which are not obvious over the claims 1-10 of copending application serial No. 10/506,488 - which are limited to vibration-absorbing mount applications.

For example, in the case of sealing materials for cam covers and oil pans, it is important to provide a sealing material that can limit the fastening/sealing pressure. Otherwise, cam covers and oil pans can tend to become deformed when excessive pressures are required to seal these articles due to their relative thinness and particularly as they are lately fabricated from resinous materials.

Vibration-absorbing materials have no nexus or obvious application to such sealing materials.

A similar or perhaps stronger argument applies to wire harness seals. That is, there is no relationship between wire harness seals and vibration adsorbing mounts.

Accordingly, the vibration-absorbing materials of copending application serial No. 10/506,488 do not render pending claims 2-5, and 15-18 obvious as required under 35 U.S.C. §103.

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It is noted that in response to the above arguments which were presented previously, the Examiner stated position is that:

...both the present invention and that of the copending Application claim materials. Note that "for vibration-absorbable mounts" in the copending Application is merely an intended use. In addition, unless Applicants can show otherwise, the present invention does not exclude the possibility of the material having the characteristics of the material in the copending Application.

The Examiner's position regarding "intended use" fails to take into consideration that the present claims are "combination" claims which include specific use limitations which copending application serial no. 10/506,488 does not suggest at all.

Accordingly, the provisional double patenting rejection should properly be withdrawn.

In applying the teachings of Fujita et al. to reject the claims the Examiner has previously stated:

Note the intended uses of the material set forth in the instant claims do not carry any weight of patentability.

This position appears to have been maintained by the Examiner even though the present claims are "combination" claims which recite specific use of the sealing material.

It is noted that the Examiner has not rejected claim 19 over Fujita et al. since this claim specifically recites an automobile wire harness.

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It is noted that claims 2, 7 and 15 have been changed to recite the combination of a sealing material with an automobile cam cover (claim 2), an automobile engine oil pan (claim 7) and an automobile wire harness (15).

Accordingly, Fujita et al. is no longer applicable as anticipating the limitations of these claims, inasmuch as they do not merely claim the sealing material, but the combination of a sealing material with an automobile cam cover (claim 2), an automobile engine oil pan (claim 7) and an automobile wire harness (15).

That is, as the Examiner has concluded. Fujita et al. does not teach a seal in combination with automobile cam cover or in combination with an automobile wire harness - or in combination with an automobile engine oil pan.

Moreover, Fujita et al. is no longer applicable to the claims which depend from claims 2, 7 and 15.

The Examiner has relied upon Lopez-Crevillen et al. as disclosing:

...an automobile engine oil pan sealed by a unitary resilient vibration absorbing seal.

In combining the teachings of Lopez-Crevillen et al. and Fujita et al. the Examiner takes the position that:

....it would have been obvious...to utilize JP255's sealing material for Lopez's oil pan seal material with expected success.



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Lopez-Crevillen et al. is directed to a "mounting arrangement" that, in addition to including a seal, includes a particular shape for the seal, support members 51, sleeves 56, etc. which are shown in cross-section in Fig. 3. In Lopez-Crevillen et al. the "mounting arrangement" includes sleeve elements 56 which "limit the compression of the seal to a predetermined amount so that the resilient vibration isolating qualities of the seal are preserved." (column 3, lines 65-68)

There are no specific requirements for the sealing material in Lopez-Crevillen et al. At column 2, lines 48-51 Lopez-Crevillen et al. teaches that "Seal is preferably formed of a low durometer elastomer, such as silicone, having a substantial resilience to make it capable of absorbing vibrations."

The Examiner has stated that paragraph [0086] of Fujita et al. "teaches a sealing material....that has vibration absorption capability for using in automobile engines" (See previous Office Action at page 6).

The Examiner has further stated that paragraph [0086] of Fujita et al. "teaches a sealing material....that has vibration and noise absorption capability for electronic devices" (See previous Office Action at page 7).

The exact context of the reference to "vibration absorption capability for using in automobile engines" is unclear.

The undersigned requests a copy of any translation of Fujita et al. the Examiner may have and is relying upon in order to have the opportunity to be able to review such a translation and rebut the Examiner's position. If the Examiner is relying upon an English translation of Fujita et al. which is

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not available to the undersigned, failing to provide such English translation will unfairly prejudice applicants' right to review and rebut the prior art rejection of the claims.

As the Examiner is no doubt aware, it is not enough that the teachings of two or more references can be combined. In order to be "obvious" there must be something to suggest the combination and some resulting benefit of the combination.

The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ 2d 1468, 1475 (Fed. Cir. 1988)

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 USPQ 870, 872 (Fed. Cir. 1985)

In order for a combination of references to render an invention obvious, the combination of the teachings of all or any of the references must suggest, expressly or by implication, the possibility of achieving further improvement by combining such teachings along the line of the invention, and that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. *In re Sernaker*, 217 USPQ 1 CAFC 1983

In the present situation, there is no motivation to use any particular elastomer as the seal in Lopez-Crevillen et al. such as the curable composition of Fujita et al.

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It is submitted that absent reliance upon applicants' own disclosure the teachings of Lopez-Crevillen et al. and Fujita et al. would not provide any particular motivation for their combination or suggest any particular benefit for the combination.

Moreover, as discussed above, applicants' have established improved properties of the claimed sealing materials which the prior art does not teach or suggest, including the limited fastening/sealing pressure noted above, the ability to be easily replaced (be cause of the low sealing pressure requirement), excellent sealability under heat and oil environments, tight adhesiveness to electric wires and good cleanliness (or low out gassing properties).

These improved properties provide particular benefits for the use of the sealing materials in conjunction with automobile cam covers, engine oil pans and wire harnesses.

In particular with regard to engine oil pans, the sealing materials are particularly suitable for use with oil pans that tend to become deformed when excessive pressures are required to seal these articles due to their relative thinness and particularly as they are lately fabricated from resinous materials.

Such use or improvement is not at all suggested or obvious over Lopez-Crevillen et al. inasmuch as Lopez-Crevillen et al. teaches a mechanical arrangement for holding and compressing the seal.

Moreover, Lopez-Crevillen et al. teaches that the "oil pan 27 is preferably made of formed sheet steel." (column 2, lines 12-13)

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Accordingly, Lopez-Crevillen et al. does not recognize, and therefore does not address or solve, problems that are related to oil pans that tend to become deformed if too much sealing pressure is applied thereto.

The properties of applicants' sealing materials are thus believed to distinguish applicants' claimed sealing materials and rebut the Examiner's basis of obviousness over the prior art.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover, the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a prima facie case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejections of the claims and an early allowance of the claims is believed to be in order.


It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

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If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,

  
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